

Application No. 10/709,535
Technology Center 3733
Amendment dated October 9, 2007
Reply to Office Action dated July 6, 2007

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REMARKS

As of the filing of the present Office Action, claims 1-25 were pending in the above-identified US Patent Application. In the Office Action, the Examiner objected to Applicant's oath and rejected all of the claims under 35 USC §103 in view of U.S. Patent No. 5,496,373 to Schmidt. In response, Applicant has amended the claims as set forth above. More particularly:

Independent claims 1 and 20 have been amended to clarify that at least a portion of the second elongate member (22,62,102) disposed within the channel (20,60,100) is externally visible as a result of the channel (20,60,100) being open along the exterior surface (18,58,98) between the first and second ends (14,16,54,56,94,96) of the first elongate member (12,52,92). Support for this limitation can be found in Applicant's Figures 1-4.¹

Dependent claim 2 and independent claim 20 have been broadened to allow for the use of any cellulosic materials, and not just wood. Support for

¹ According to MPEP §2163 II.A.3(a), "drawings alone may provide a 'written description' of an invention as required by [35 USC §112, first paragraph]," and "[i]n those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification." (Citations omitted).

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this limitation can be found in Applicant's specification at paragraph [0006].²

Independent claim 15 has been amended to specify that the solid elongate members (132,134,136,152,154,156,172,174,176) are nontubular and longitudinally spaced apart from each other, their adjacent facing ends are longitudinally spaced apart from each other so as to define a longitudinally gap therebetween, and the securing means (140,160,180) therebetween space the elongate members (132,134,136,152,154,156,172,174,176) longitudinally apart. Support for these limitations can be found in Applicant's Figures 5-7.

Finally, dependent claim 19 has been amended to further recite a securing means (180) that interconnects a cylindrical surface of the transverse member (178) to one of the elongate members (176). Support for this limitation can be found in Applicant's Figure 7.

Applicant believes that the above amendments do not present new matter. Favorable reconsideration and allowance of claims 1-25 are respectfully requested in view of the above amendments and the following remarks.

² All references to pages and paragraphs in Applicant's electronically-filed application are those inserted by the USPTO authoring software.

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Oath/Declaration

The Examiner advised that Applicant's oath was defective. In response, Applicant submits herewith a corrected "Declaration and Power of Attorney" that is believed to address and overcome the defect cited by the Examiner. Applicant therefore respectfully requests withdrawal of this objection.

Rejection under 35 USC §103

Independent claims 1, 15, and 20 and their dependent claims were rejected solely on the basis of U.S. Patent No. 5,496,373 to Schmidt. However, Schmidt is limited to telescopically assembled parts, such that the entire portion of a tube (e.g., 11) telescopically received within a second tube (e.g., 9) is concealed by the second tube. In contrast, Applicant's claims 1-14 and 20-25 require an external channel (20,60,100) in a first elongate member (12,52,92) in which a second elongate member (22,62,102) is disposed. Because the channel (20,60,100) is defined in the exterior surface (18,58,98) of the first elongate member (12,52,92), at least a portion of the second elongate member (22,62,102) disposed within the channel (20,60,100) is externally visible. Schmidt does not provide any motivation for assembling his

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tubes in any other manner except telescopically, and doing so would be contrary to the advantages espoused by Schmidt for his use of "readily available plastic tubing and coupling" to make an adjustable prosthetic unit.

Schmidt also does not disclose or suggest longitudinally spacing his tubes apart, so that their adjacent ends are longitudinally spaced apart. Instead, all interconnected ends of Schmidt's tubes are received inside each other. As such, Schmidt does not disclose or suggest Applicant's claims 15-19, which require such a longitudinally spaced-apart construction.

In setting forth the rejections, the Examiner stated that "Schmidt discloses the claimed invention including a prosthetic device comprising multiple elongate members, a plurality of bores, block members and fastening means," and though "Schmidt does not explicitly recite that the device may be formed of wood," doing so would be obvious "as a matter of obvious design choice." However, this basis for asserting a rejection is contrary to *In re Wright*, 6 USPQ2d 1959, 1961 (Fed. Cir. 1988), whose court stated

it is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves.

The Examiner's explanation for asserting the rejection did not address the

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structural differences between Schmidt's telescopically-assembled tubes which are not spaced apart from each other, and Applicant's elongate members that are assembled via "a channel in [an] exterior surface between the first and second ends [of a first of the elongate members]" (original claims 1-14 and 20-25), and Applicant's elongate members having "adjacent facing ends that are spaced apart from each other" (original claims 15-19). Finally, the problem solved by Applicant - the prior requirement to remove osteoprosthetic devices prior to cremation - is completely different from that solved by Schmidt - problems with prior art "artificial bone replacement[s]" whose attachment screws loosen during assembly and whose interconnecting members are too large (see Schmidt's "Background of the Present Invention"). To solve this problem, Schmidt specifically proposes a "telescopic bone replacement apparatus and system" - which is completely contrary to Applicant's claimed invention.

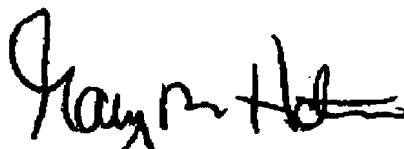
For the above reasons, Applicant believes the rejection of the claims is improper, and in any event the claims as now amended clarify the differences between Applicant's invention and Schmidt. As such, Applicant respectfully requests withdrawal of the rejection under 35 USC §103(a).

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Closing

In view of the above, Applicant respectfully requests that his patent application be given favorable reconsideration. Should the Examiner have any questions with respect to any matter now of record, Applicant's representative may be reached at (219) 462-4999.

Respectfully submitted,



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Attachment: Declaration and Power of Attorney